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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,265	03/02/2005	Franz Riedl	72.100	6597
23598 7590 09/18/2008 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
			EXAMINER JOHNSON, MATTHEW A	
			ART UNIT 3682	PAPER NUMBER
			NOTIFICATION DATE 09/18/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/526,265

Applicant(s)

RIEDL, FRANZ

Examiner

MATTHEW JOHNSON

Art Unit

3682

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 3/2/2005.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "imbalance shafts that stand parallel or coaxial to one another" must be shown or the feature(s) canceled from the claim(s). While the drawings show two parallel imbalance shafts, the figures do not appear to show two coaxial imbalance shafts. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: on the last line of page 1, the phrase "soil is reduced to 1/2 of the maximum value" appears to be a typo.

Appropriate correction is required.

Claim Objections

3. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 2 appear to recite the same limitations recited in lines 9-12 of claim 1.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitation "for adjusting the position" in line 6. There is insufficient antecedent basis for "the position" in the claim.

Re clms 1-5 and 8: There is insufficient antecedent basis for the phrase "the relative positions".

Re clm 2: Regarding the phrase "borne by this imbalance shaft", it is unclear which imbalance shaft Applicant is referring to.

Re clm 4: Regarding the phrase "relative positions defined in claim 1", it is unclear what relative positions Applicant is referring to.

Re clm 7: The limitation "wherein the phase position of the imbalance shafts to one another cannot be modified", is unclear rendering the claim indefinite. While it is understood that the imbalance shafts have a fixed eccentric mass that is not modifiable, the imbalance shafts also carry a movable eccentric mass where the phase position is modifiable through the adjustment means. It is unclear how the device can modify the phase position of movable mass without modifying the phase position of the imbalance shafts to one another.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada (USP-5,177,386).

Re clms 1 and 2: Shimada discloses a vibration exciter comprising imbalance shafts (21, 22) that stand parallel to one another (Fig. 2) and that can be driven in opposite directions with the same rotational speed (Abstract), each of the imbalance shafts bearing an imbalance mass (51Aa, 51Ab, 52Aa, 52Ab) attached to it in stationary fashion (Fig. 2) and an imbalance mass (51B, 52B) that can be moved in a rotational fashion relative to the shaft (Abstract), and each of the imbalance shafts having allocated to it an adjustment means (32, 34) for adjusting the position of the respective movable imbalance mass relative to the imbalance shaft that bears it (C5 51-56). Regarding the limitations, "during operation, the relative positions can be adjusted using the adjustment means in such a way that the centrifugal forces produced by the imbalance masses during the rotation of the imbalance shafts cancel each other out as a whole in each rotational position of the imbalance shafts, a change of the relative position can be executed in such a way that the magnitude of an overall centrifugal force resulting from the imbalance masses is proportional to a speed of forward motion of the coil compacting device" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all claimed structural limitations and therefore anticipates the claim (See MPEP 2114). Additionally, the adjusting device of Shimada is capable of performing the function (C8 L5-12, see also Figs. 4a and 5a).

Re clm 3: Shimada discloses in order to effect a forward motion of the soil compacting device in a first horizontal direction, the relative positions are capable of

being modified in such a way that the centrifugal forces of the imbalance masses do not cancel one another, rather, an overall centrifugal force resulting from the centrifugal forces has a horizontal component (C8 L1-33).

Re clm 4: Regarding the limitations, "when there is a change between the first direction and an opposite, second direction, the relative positions defined in claim 1 are capable of being assumed during the transition" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all claimed structural limitations and therefore anticipates the claim (See MPEP 2114). Additionally, the adjusting device of Shimada is capable of performing the function.

Re clm 5: Shimada discloses the change of the relative positions can be executed continuously (via the adjustment means).

Re clm 6: Shimada discloses the imbalance shafts are coupled with one another positively so as to be capable of rotation in opposite directions (Abstract).

Re clm 7: Shimada discloses the phase position of the imbalance shafts to one another cannot be modified (the fixed masses on the shafts are not modifiable).

Re clm 8: Ferever discloses the adjustment of the relative positions on the imbalance shafts using the adjustment means can be executed synchronously (C7 L25-28).

Re clm 9: Shimada discloses the adjustment means can be actuated hydraulically (C3 L33-48).

Re clm 10: Shimada discloses at least one part of the imbalance masses is formed from a plurality of imbalance elements (51Aa, 51Ab, 52Aa, 52Ab, see also Fig. 2).

9. Claims 1-9, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by DE-100 38 206 (for citations refer to English version Fervers et al. USP-7,171,866).

Re clms 1 and 2: Fervers discloses a vibration exciter comprising imbalance shafts (2, 3) that stand parallel to one another (Fig. 1) and that can be driven in opposite directions with the same rotational speed (C4 L1-5), each of the imbalance shafts bearing an imbalance mass (15) attached to it in stationary fashion (Fig. 1) and an imbalance mass (16) that can be moved in a rotational fashion relative to the shaft (C4 L56-61), and each of the imbalance shafts having allocated to it an adjustment means (17, 18) for adjusting the position of the respective movable imbalance mass relative to the imbalance shaft that bears it (C5 L4-12). Regarding the limitations, "during operation, the relative positions can be adjusted using the adjustment means in such a way that the centrifugal forces produced by the imbalance masses during the rotation of the imbalance shafts cancel each other out as a whole in each rotational position of the imbalance shafts, a change of the relative position can be executed in such a way that the magnitude of an overall centrifugal force resulting from the imbalance masses is proportional to a speed of forward motion of the coil compacting device" the examiner notes while features of an apparatus may be recited either structurally or functionally,

claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all claimed structural limitations and therefore anticipates the claim (See MPEP 2114). Additionally, the adjusting device of Ferver is capable of performing the function as a result of the wide range of adjustability (C2 L9-12, C3 L27-39, C5 L22-31).

Re clm 3: Fervers discloses in order to effect a forward motion of the soil compacting device in a first horizontal direction, the relative positions are capable of being modified in such a way that the centrifugal forces of the imbalance masses do not cancel one another, rather, an overall centrifugal force resulting from the centrifugal forces has a horizontal component (Fig. 2, C5 L49-56).

Re clm 4: Regarding the limitations, "when there is a change between the first direction and an opposite, second direction, the relative positions defined in claim 1 are capable of being assumed during the transition" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all claimed structural limitations and therefore anticipates the claim (See MPEP 2114). Additionally, the adjusting device of Ferver is capable of performing the function as a result of the wide range of adjustability.

Re clm 5: Ferver discloses the change of the relative positions can be executed continuously (C3 L27-30).

Re clm 6: Ferver discloses the imbalance shafts are coupled with one another positively so as to be capable of rotation in opposite directions (C4 L1-5).

Re clm 7: Ferver discloses the phase position of the imbalance shafts to one another cannot be modified (see page 4 lines 4-8 of Applicants specification).

Re clm 8: Ferver discloses the adjustment of the relative positions on the imbalance shafts using the adjustment means can be executed synchronously (C3 L10-17).

Re clm 9: Ferver discloses the adjustment means can be actuated hydraulically (C4 L31-35).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW JOHNSON whose telephone number is (571)272-7944. The examiner can normally be reached on Monday - Friday 8:30a.m. - 5:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J./
Examiner, Art Unit 3682

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3682